

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/581,858

Applicant(s)

ITOU ET AL.

Examiner

JONATHAN G. LEONG

Art Unit

1725

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 26 January 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 102b under Nagayama, 102b under Yamamoto.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3 and 6.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Basia Ridley/
Supervisory Patent Examiner, Art Unit 1725

Continuation of 11, does NOT place the application in condition for allowance because: Initially, the Examiner acknowledges the Declaration under 37 CFR 1.132. The Examiner notes that the evidence of unexpected results is deficient at least since it is not reasonably commensurate in scope with the prior art reference Mao et al. (US 6071649) in view of Huang (US 2003/0157490) as evidenced by Nagayama (JP H07-245105). This is because the evidence has a coating of Lithium carbonate while Mao discloses a coating of lithium cobaltate. Thus, the Examiner cannot determine if there are unexpected results from substituting lithium sulfate with lithium cobaltate. Further, it is unclear to the Examiner if the showing of evidence is repeatable as there are no error bars or standard deviation notation. The showing of evidence appears to have 3 curves while the evidence within the argument appears to have 4 curves. Only two of the curves are labeled, it is unclear to the Examiner what the other two curves represent. The Examiner notes that the original instant specification at page 7 line 14-30 seems to allow for lithium cobaltate, lithium carbonate, lithium sulfate and many others in order to obtain preferred results without singling out specific lithium compounds. Additionally, the evidence does not make clear if the amount of deposited lithium compound is the same between lithium carbonate and lithium sulfate, that is, it is unclear if the lithium carbonate was deposited in a thinner coating than the lithium sulfate (or vice-versa or some other difference in deposition such as incomplete surface coverage). The original instant specification at P16/L13-23 appears to disclose the importance of the amount of lithium compound deposited. Since the showing of evidence is unclear as to such deposition detail, the Examiner cannot determine if the comparison between Li carbonate and Li sulfate was done with substantially the same amounts of deposition which is a variable (among others) that could affect relative performance. The showing of evidence lacks details pertaining to the experimental comparison, i.e. fixed variables, so that the Examiner can determine a fair comparison has been shown.